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Intellectual Property Causes
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IPU

Attorney Docket No. P24743

In re application of: H. RINGHOFF et al.

Application No. : 10/776,269

Filed : February 12, 2004

For : TIRE BUILDING ARRANGEMENT AND METHOD

Mail Stop Amendment
Group Art Unit: 1733

Examiner: G. L. Knable

Mail Stop Amendment

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is an **Election with Traverse** in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ A Request for Extension of Time.

☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 40	40	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 3	3	0	x 44=	\$	x 88=	\$0.00
Multiple Dependent Claims Presented			+150=	\$	+300=	\$0.00
Extension Fees for ____ Month(s)				\$		\$0.00
Total:				\$	Total:	\$0.00

* If less than 20, write 20

** If less than 3, write 3

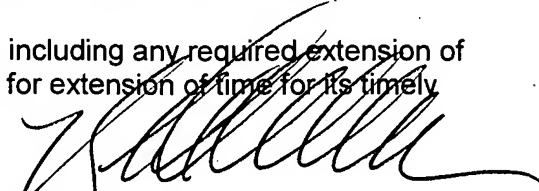
☐ Please charge my Deposit Account No. 19-0089 in the amount of \$ ____.

☐ A check in the amount of \$ ____ to cover the filing/extension fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).


Neil F. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,043

P24743.A02



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : H. RINGHOFF et al. Confirmation No. 5503
Serial No : 10/776,269 Group Art Unit: 1733
Filed : February 12, 2004 Examiner: G. L. Knable
For : TIRE BUILDING ARRANGEMENT AND METHOD

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Amendment
Randolph Building
401 Dulany Street
Alexandria VA 22314

Sir:

In response to the Examiner's restriction requirement of March 22, 2006, the time set for response being one month, i.e., April 24, 2006 (April 22, 2006 being a Saturday), Applicant hereby elects the invention of Group I directed to claims 1-34 with traverse.

In the instant Official Action, the Examiner indicated that all claims (i.e., claims 1-40) were subject to restriction under 35 U.S.C. § 121. The Examiner restricted the claimed invention into Group I, including claims 1-34, and drawn to an arrangement for building tires, classified in class 156, subclass 396, and Group II, including claims 35-40, and drawn to a tire building method, classified in class 156, subclass 111.

The Examiner asserted that the inventions of Groups I and II were related as process and apparatus for its practice. The Examiner also asserted that the invention groups are distinct from each other under M.P.E.P. § 806.05(e).

Applicant respectfully submits that the instant restriction requirement is improper at least because the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

While the Examiner has alleged possible distinctions between the identified groups of invention, the Examiner has not shown that a concurrent examination of these groups would present a "serious burden." In fact, the Examiner has failed to specify any appropriate statement that the search areas required to examine the invention of Group I would not overlap into the search areas for examining the invention of Group II, and vice versa.

Applicant respectfully submits that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap. Indeed, the claims of Group II specifically depend from the claims of Group I. Furthermore, the Examiner has acknowledged that each Group would require searching in the same class, i.e., class 156. Additionally, both groups of claims have a number of features in common such as the features of claims 1, 31 and 34.

Because the search for each group and species of invention is apparent substantially the same (for purposes of examination), Applicant submits that no undue or serious burden would be presented in concurrently examining Groups I-II. Thus, for the above-noted reasons, and consistent with the Office policy set forth above in M.P.E.P. §

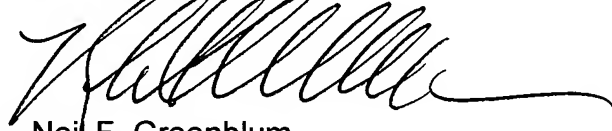
P24743.A02

803, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction and species requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicant has elected, with traverse, the invention defined by Group I directed to claims 1-34, in the event that the Examiner chooses not to reconsider and withdraw the restriction and/or species requirement.

Please charge any additional fees necessary for consideration of the papers filed herein and refund excess payments to Deposit Account No. 19-0089.

Respectfully submitted,
H. RINGHOFF et al



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April 24, 2006
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